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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/669,653

09/25/2003

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23373 7590 10/27/2011
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EXAMINER

MOTSINGER, SEAN T

ART UNIT

PAPER NUMBER

2624

NOTIFICATION DATE

DELIVERY MODE

10/27/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROAKI NAKAMURA and TOSHIHIKO KAKU

Appeal 2010-000160
Application 10/669,653
Technology Center 2600

Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and THU A.
DANG, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellants appeal from the Examiner's final rejection of dependent claims 1-13 under 35 U.S.C. § 134(a) (2007). We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We affirm in part.

A. INVENTION

According to Appellants, the invention relates to an image recording apparatus for recording an image corrected through an application of a predetermined correcting processing to an original image (Spec. 1, ll. 7-11).

B. ILLUSTRATIVE CLAIM

Claims 1 and 9 are exemplary and are reproduced below:

1. An image recording apparatus comprising:

an image data input section that enters image data representative of an original image;

an image correcting section that applies a predetermined correcting processing to the original image represented by the image data entered through the image data input section to create a corrected image; and

an image recording section that records the corrected image subjected to the correcting processing in the image correcting section onto a first external media for recording an image in a form of either one of an image recording on a visual basis and a recording of image data, and records either one of a set of image and information capable of reproducing the original image and the original image onto a second external media for recording an image in form of either one of an image recording on a visual basis and a recording of image data.

9. An image recording apparatus comprising:

an image data input section that enters original image data representative of an original Image;

an image correcting section that applies a predetermined correcting processing to the original image data to create corrected image data, and transmits the corrected image data and original image data together to the image recording section; and

an image recording means for recording one of: a) a corrected image corresponding to the corrected image data subjected to the correcting processing and b) the corrected image data onto a first external media for recording one of: an image perceived on a visual basis and a recording of corrected image data as electronic data, said image recording means for further recording one of a) the image data capable of reproducing the original image and b) the original image onto a second external media for recording one of: an image perceived on a visual basis and a recording of the original image data as electronic data.

C. REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Shiota	US 6,346,998 B2	Feb. 12, 2002
White	US 7,035,462 B2	Apr. 25, 2006
		(filed on Aug. 29, 2002)

Claims 6, 10 and 11 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1-4 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention.

Claims 1-3 stand rejected under 35 U.S.C. § 102(e) as anticipated by the teachings of White.

Claim 4 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the teachings of White.

Claims 5-8 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the teachings of White and Shiota.

Claims 9-13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the teachings of Shiota and White.

II. ISSUES

Has the Examiner erred in concluding that:

1) the language “an image in a form ... of an image recording on a visual basis and a recording of image data” and “reproducing the original image and the original image” (claim 1) is so ambiguous that one of ordinary skill in the art cannot determine its scope absent speculation or

2) Shiota in view of White would have suggested “an image correcting section that ... transmits the corrected image data and original image data together to the image recording section” (claim 9)?

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Shiota

1. Shiota discloses compressing means 4 for compressing image data processed by the image processing means 3a and a medium drive 13 for recording the processed image data as compressed image file in a recording medium 6, wherein the image data processed by the image processing means 3b are output as print 7 by a digital printer (col. 8, ll. 60-65; Fig. 1).
2. The print output and the file output for each image data are output together (col. 8, ll. 66-67).

White

3. White discloses that metadata can be attached to or associated with the digital file of the image to store information or data (col. 14, ll. 1-2), wherein all the corrections are stored so that the original image can be recovered by successively undoing the corrections (col. 14, ll. 38-40).

IV. ANALYSIS

112, 1st Paragraph

As to claims 6, 10, and 11, the Examiner finds that “[t]he claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention” (Ans. 3). In particular, the Examiner finds that “[c]laims

6 and 10 recite ‘transmits the corrected image and image data simultaneously to the image recording section’ which is missing from the application as originally filed” (*id.*). Similarly, the Examiner finds that “[c]laim 11 recites ‘transmits the corrected image and image data sequentially to the image recording section’ which is missing from the application as originally filed” (*id.*).

Appellants argue that “the specification recites that the corrected image data and photographic image data are transmitted together to the image recording section” (App. Br. 12). Appellants then argue that “[i]t would be inherent that if the image data and corrected image data were transmitted together then the data transmission would also be simultaneously transferred” (*id.*). Appellants also argue that “Appellants’ specification teaches that an operator may designate the first external media and the second external media by using a mouse,” and thus “it is clear that the specification teaches the sequential data transmission” (App. Br. 13).

After reviewing the Specification as originally filed, we agree with the Examiner that the Specification does not provide support for transmitting a corrected image and image data “simultaneously” or “sequentially” (Ans. 3). As admitted by Appellants, the Specification discloses that “the specification recites that the corrected image data and photographic image data are transmitted together to the image recording section” (App. Br. 12, emphasis added). As admitted by Appellants in the Appeal Brief, “together” is not necessarily (i.e., inherently) “simultaneously” since it could mean “sequentially” (App. Br. 13). Similarly, it is not clear that the Specification teaches sequential transmission because the Appellants admit in the Appeal Brief that the transmission could be simultaneous (App. Br. 12). Thus, we

agree with the Examiner that “the word together is much broader and much less specific [than] the word simultaneously (or sequentially)” (Ans. 13).

Thus, we are not persuaded that the Examiner erred in concluding that claims 6, 10 and 11 do not have support in the originally filed Specification to evidence possession as required by 35 U.S.C. § 112, first paragraph.

112, 2nd Paragraph

As to claim 1, the Examiner points out that “the phrase ‘records at least either one of a set of image and information capable of reproducing the original image and the original image and the original image a second external media for recording an image in form of at least either one of an image recording on a visual basis and a recording by image data’ does not make any sense” (Ans. 4).

We find that independent claim 1 on appeal is so abstract in recitation that the claim is deemed indefinite. That is, we cannot determine the metes and bounds of the claim as required to ascertain its scope of the claimed invention. In particular, we are unclear as to what the phrase “records ... onto a first external media for recording an image in a form of either one of an image recording on a visual basis and a recording of image data” and “records either one of a set of image and information capable of reproducing the original image and the original image” (claim 1) is to include, mean or represent. That is, we are unclear as to what is “recording an image in a form of ... an image recording on a visual basis” (*id.*). Similarly, we are unclear as to what is “reproducing the original image and the original image” (*id.*). Though a claim is read in view of the Specification, Appellants’ Specification does not shed any light as to the meaning of the phrase.

Therefore, we find it unclear as to what the language of claim 1 is directed. When a claim becomes so ambiguous that one of ordinary skill in the art cannot determine its scope absent speculation, such claim is invalid for indefiniteness. *In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962).

Here, we conclude that claim 1 does not reasonably apprise those skilled in the art of its scope. Because we conclude that there are significant ambiguities with respect to claim 1 and thus to each of the claims depending therefrom, we affirm the Examiner's rejection under 35 U.S.C. § 112, second paragraph, against claim 1 and claims 2-4 depending therefrom.¹

Claims 1-8

We reverse the outstanding rejection of claims 1-3 under 35 U.S.C. § 102(e) and of claims 4-8 under 35 U.S.C. § 103(a), *pro forma*, because we conclude that at least independent claim 1 is indefinite under 35 U.S.C. § 112, second paragraph, as detailed above. That is, the claims on appeal must be reasonably understood without resorting to speculation to thereby prevent the rejections of the claims over prior art from being based on speculation and assumptions as to the scope of the claims. *See Steele*, 305 F.2d at 862. Presently, the claims on appeal do not adequately reflect what the disclosed invention is. We are therefore declining from utilizing speculation and conjecture in an attempt to ascertain the scope of the claims.

Claims 9-13

Appellants argue that Shioti "shows that an output of an image processing means 3 will separate the image (printer path 7) from the image

¹ We additionally note that the same rejection could be applied against dependent claims 5-8 but the Examiner has not rejected these claims even though they contain the same deficient subject matter as independent claim 1 from which they depend.

data (medium path 6),” and thus “Shiota does not disclose or suggest ‘transmits the corrected image data *and* original image data *together*” (App. Br. 21). However, the Examiner finds that in Shiota, “two images are transferred from the processor to the output equipment/ports which are collectively the ‘image recording section’” (Ans. 24).

To determine whether Shiota in view of White would have suggested “an image correcting section that ... transmits the corrected image data and original image data together to the image recording section” as recited in claim 9, we give the claim its broadest reasonable interpretation consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). However, we will not read limitations from the Specification into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

Claim 9 does not provide any definition as to what an “image recording section” is to mean, include or represent, other than that the correct image data and the original image data are transmitted to the “image recording section” together. Thus, we broadly but reasonably interpret the “image recording section” as a section comprising any device(s) for recording images, as consistent with the Specification.

Shiota discloses outputting processed image data as a compressed image file in a recording medium and as print by a digital printer (FF 1), wherein the print output and the file output for each image data are output together (FF 2). We find the recording medium for recording the compressed image file to comprise a device for image recording. Similarly, we find the print output to also comprise a device for image recording. We thus find Shiota to disclose an image recording section comprising devices

for image recording. As the data are output together, we find Shiota to at the least suggest transmitting the corrected image data and original image data “together” as required by claim 9.

Even Appellants admit that Shiota shows that the processing means outputs to the printer path and the medium path (App. Br. 21). Though Appellants appear to argue that outputting to the printer path and the medium path cannot be “together” because they are “separate,” nothing in the language of claim 9 precludes such separate paths, as long as the data are output “together” to the same “image recording section.” We agree with the Examiner’s finding that “the output equipment/ports ... are collectively the ‘image recording section’” (Ans. 24).

Though Appellants also assert that “Shiota fails to teach or suggest an ‘image data *capable of reproducing the original image*’, or ‘*the original image*’ onto a second external media” (App. Br. 21), Appellants appear to be arguing that Shiota does not individually anticipate the claimed invention. However, the Examiner has rejected the claims as obvious over the combined teachings of Shiota and White. Contrary to Appellants’ apparent argument, the test for obviousness is not what Shiota shows but what the *combined* teachings *would have suggested* to one of ordinary skill in the art. See *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

As discussed above, Shiota discloses recording information or data of an image (FF 1). Further, White discloses that metadata can be attached to or associated with the digital file of the image, wherein all the corrections are stored/recorded so that the original image can be recovered by

successively undoing the corrections (FF 3). We find White to disclose recording image data capable of reproducing the original image.

We agree with the Examiner that Shiota in view of White would have suggested at least recording the image capable of producing the original image, as required by claim 9.

As for claims 10 and 11, Appellants repeat that “Shiota clearly shows that an output of an image processing means 3 will separate the image (printer path 7) from the image data (medium path 6)” (App. Br. 22). As discussed above, we interpret the “image recording section” broadly but reasonably as comprising the print and the recording medium in one single section. Thus, we find Shiota discloses transmitting the corrected image and the image data simultaneously and sequentially to the image recording section. Accordingly, we affirm the rejection of claims 9-11 over the teachings of Shiota and White. Appellants do not provide arguments for claims 12 and 13 separate from those of claim 9 from which they depend. Accordingly, claims 12 and 13 fall with claim 9.

V. CONCLUSION AND DECISION

The Examiner did not err in concluding that claims 6, 10 and 11 contain subject matter which was not described in the Specification as required under 35 U.S.C. § 112, first paragraph, and that claims 1-4 are indefinite under 35 U.S.C. § 112, second paragraph. The Examiner also did not err in finding claims 9-13 unpatentable under 35 U.S.C. § 103(a). However, we reverse the outstanding rejection of claims 1-3 under 35 U.S.C. § 102(e) and of claims 4-8 under 35 U.S.C. § 103(a), *pro forma*.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED IN PART

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